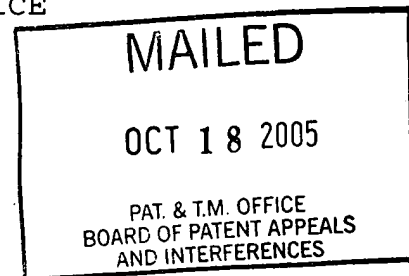


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES



Ex parte MICHAEL G. PHILLIPS, CHAPMAN M. FINDLAY III,  
STEPHEN A. KLEIN, WILLIAM P. JENNINGS, and MARK E. RICE

Application No. 09/615,021

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on August 30, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

A review of the application indicates that the Evidence appendix and Related proceedings appendix sections are missing from the appeal brief filed May 16, 2005. Therefore, the appeal brief does not comply with all the requirements of 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items

under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A substitute brief that is in compliance with 37 CFR § 41.37(c) is required. For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Also, the examiner's answer mailed on June 16, 2005 is not in compliance with the requirements of 37 CFR § 41.37. The following headings need to be corrected in order to be consistent

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with the appeal brief filed May 16, 2005:

*Summary of the Claimed Subject Matter* - replacing the Issues section in paragraph (6).

*Evidence Relied Upon* - replacing the prior art of record section in paragraph (9).

*Grounds of rejections to be Reviewed* - replacing the Grouping of Claims and Grounds of Rejection sections in paragraphs (7) and (10).

*Arguments* - replacing the Response to Argument section in paragraph (11) and should contain separate arguments for each claim that is under a subheading in the appeal brief.

*Acknowledgment of the Related Proceedings and Evidence appendices, if applicable.*

A revised examiner's answer that is in compliance with 37 CFR § 41.37 is required.

In addition, there is no indication that an appeal conference was held because the examiner's answer contains only the typed name (i.e., Dr. N. Subramanian) of the conferee. No signature or initialing by the conferee is present. The Manual of Patent Examining Procedures (MPEP) § 1208 states:

The participants of the appeal conference should include (1) the examiner charged with preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal.

Upon receipt of the appeal case by the Board of Patent Appeals and Interferences (Board), the Board should review the application prior to assigning an appeal

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number to determine whether an appeal conference has been held.

Accordingly, it is

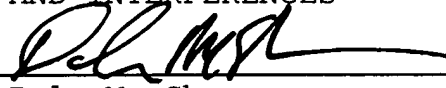
ORDERED that this application be returned to the examiner to: 1) hold the appeal brief of May 16, 2005 defective; 2) request appellants to file a substitute appeal brief in compliance with 37 CFR § 41.37; 3) vacate the examiner's answer and submit a revised examiner's answer in response to the substituted appeal brief and in accordance with the new rules effective September 13, 2004; 4) proper indication that an appeal conference was held; 5) notifying the appellants, in writing, that the appeal conference was held; and 6) for such further action as may be appropriate.

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of this appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: \_\_\_\_\_



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DMS/tdl